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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,652	11/26/2001	Daniel C. Shaw	6278.244a	4497

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EXAMINER

FETSUGA, ROBERT M

ART UNIT

PAPER NUMBER

3751

DATE MAILED: 04/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

50

**Office Action Summary**

Application No.

09/991,652

Applicant(s)

Shaw et al.

Examiner

Robert M. Fetsuga

Art Unit

3751



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on Mar 27, 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 27-50 is/are pending in the application.
- 4a) Of the above, claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Nov 26, 2001 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- 15) ☒ Notice of References Cited (PTO-892)                      18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_                      20) ☐ Other:

Art Unit: 3751

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35

U.S.C. 120 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification (37 CFR 1.78). At least application serial nos. 09/277,872, 08/089,595 and 07/822,201 must be noted.

2. The drawings are objected to because in Fig. 4 reference character "F" apparently should be --G-- (pg. 12 ln. 22), and in Fig. 11 reference numeral "160" (left occurrence) apparently should be --166-- (pg. 22 ln. 7) and reference numeral "170" (pg. 22 ln. 8) is missing. Correction is required.

The drawings are objected to under 37 C.F.R. ' 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "light" set forth in claims 38 and 44 must be shown or the feature(s) cancelled from the claim(s). No new matter should be entered.

Applicant is required to submit a proposed drawing correction in response to this Office Action. Any proposal by the applicant for amendment of the drawings to cure defects must consist of two parts:

Art Unit: 3751

a) A *separate* letter to the Draftsman in accordance with MPEP § 608.02(r); and

b) A print or pen-and-ink sketch showing changes in *red ink* in accordance with MPEP § 608.02(v).

IMPORTANT NOTE: The filing of new formal drawings to correct the noted defect may be deferred until the application is allowed by the examiner, but the print or pen-and-ink sketch with proposed corrections shown in red ink is required in response to this Office Action, and *may not be deferred*.

3. The disclosure is objected to because of the following informalities: page 22, line 25, "188" apparently should be -- 198--. Appropriate correction is required.

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. ' 1.75(d)(1) and M.P.E.P. ' 608.01(o). Correction of the following is required: Proper antecedent basis for the "detector" set forth in claims 27, 42 and 48 could not be found in the specification.

5. The claim hierarchy does not appear to be in accordance with MPEP 608.01(m). Claims remaining at allowance may require renumbering.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. ' 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

Art Unit: 3751

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. ' 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 27, 34, 35, 48 and 49 are rejected under 35 U.S.C. ' 102(b) as being anticipated by Robertshaw.

The Robertshaw reference discloses a control system comprising: a fixture S; a source of water T; a valve SV; a detector DS (col. 1 lns. 38-40); and a controller 10,12, as claimed.

8. Claims 27, 35, 48 and 49 are rejected under 35 U.S.C. ' 102(b) as being anticipated by Atkins et al.

The Atkins et al. (Atkins) reference discloses a control system comprising: a fixture 10; a source of water (feeding 14); a valve 14; a detector 36; and a controller 18 (col. 5 ln. 6 thru col. 6 ln. 2), as claimed.

Art Unit: 3751

9. Claim 36 is rejected under 35 U.S.C. ' 103(a) as being unpatentable over Robertshaw.

The choice of delay period would appear an obvious choice to be made.

10. Claims 34 and 36 are rejected under 35 U.S.C. ' 103(a) as being unpatentable over Atkins.

The choices of controller type and delay period would appear obvious choices to be made.

11. Claims 28-33 and 42 are rejected under 35 U.S.C. ' 103(a) as being unpatentable over Atkins and Bellamy.

Utilization of the Atkins control system with a plurality of fixtures would have been obvious in order to implement the benefits of the Atkins system in a building containing a plurality of fixtures. The Bellamy reference indicates it is well known to automatically control a plurality of fixtures arranged on different floors of a building, for example. Note Fig. 9.

Re claim 30, Bellamy teaches it is desirable to operate a fixture valve by either a motor or solenoid. Note column 3, lines 11-15. Re claim 32, Bellamy further teaches it is desirable to remotely dispose a controller of a building fixture control system. Note Fig. 9.

Art Unit: 3751

12. Claims 37-39, 43, 44 and 47 are rejected under 35 U.S.C.

' 103(a) as being unpatentable over Atkins and Bellamy as applied to claim 28 above, and further in view of Morris et al.

Morris et al. (Morris) teaches provision of a valve status indicator associated with a controlled fixture to be desirable where such fixture is in a penal institution, for example. Note column 8, lines 17-35.

13. Claims 40, 41, 45, 46 and 50 are rejected under 35 U.S.C.

' 103(a) as being unpatentable over Atkins and Bellamy as applied to claim 28 above, and further in view of Fraser.

Provision of a disabling switch associated with a particular electrically controlled device operating in a system of such devices would have been obvious as being notoriously well known and desirable to prevent the particular device from operating should it be malfunctioning, for example. Furthermore, provision of a master switch associated with a control system would have been obvious as being notoriously well known and desirable. The Fraser reference illustrates in Fig. 8 a remotely disposed master switch associated with a control system.

14. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

Art Unit: 3751

Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

15. Claims 27-50 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 4,985,944. Although the conflicting claims are not identical, they are not patentably distinct from each other because the pending claims are anticipated by the patented claims and anticipation is the epitome of obviousness.

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant is referred to MPEP 714.02 when responding to this Office action.



Art Unit: 3751

17. Any inquiry concerning this communication should be directed to Robert M. Fetsuga at telephone number (703) 308-1506.

A handwritten signature in black ink, appearing to read "Robert M. Fetsuga", is written above the printed name.

ROBERT M. FETSUGA  
PRIMARY EXAMINER  
ART UNIT 3751

rmf  
April 22, 2002